

O-070-06

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2047388
IN THE NAME OF ALMIGHTY MARKETING LIMITED
OF THE TRADE MARK:**

MOO JUICE

IN CLASS 29

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY
THERE TO UNDER NO 81895
BY
MILK LINK LIMITED**

Trade Marks Act 1994

**In the matter of registration no 2047388
in the name of Almighty Marketing Limited
of the trade mark:
MOO JUICE
in class 29
and the application for a declaration of invalidity
thereto under no 81895
by Milk Link Limited**

BACKGROUND

1) An application to register the trade mark **MOO JUICE** (the trade mark) was filed on 4 December 1995. The registration process was completed on 16 August 1996. The registration stands in the name of Almighty Marketing Limited, which I will refer to as Almighty. It is registered for the following goods:

milk; milk beverages; flavoured milk; milk products; yoghurt; drinking yoghurt; flavoured yoghurt.

The above goods are in class 29 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 21 October 2004 Milk Link Limited, which I will refer to as Link, filed an application for the invalidation of the registration. Link claims that the trade mark is devoid of any distinctive character as the words MOO JUICE are descriptive of milk. Registration of the trade mark was, therefore, contrary to section 3(1)(b) of the Trade Marks Act 1994 (the Act). Link claims that the trade mark consists exclusively of signs which may serve in trade to designate the kind of goods as the words MOO JUICE are descriptive of and used in common parlance as slang for milk. Registration of the trade mark was, therefore, contrary to section 3(1)(c) of the Act. Link claims that the trade mark consists exclusively of signs or indications which have become customary in the current language as the words MOO JUICE is used in common parlance as slang for milk. Registration of the trade mark was, therefore, contrary to section 3(1)(d) of the Act. Link seeks a declaration of invalidity of the trade mark. (Link also claimed that the application to register the trade mark was made in bad faith and so contrary to section 3(6) of the Act, however, in its written submissions it dropped this claim.)

3) Almighty filed a counterstatement. Almighty denies the grounds of invalidation. It denies MOO JUICE is descriptive of milk or is used in common parlance as slang for milk. Consequently, Almighty denies that registration of the trade mark was contrary to sections 3(1)(b), (c) and (d) of the Act. Almighty states that it will file evidence that Link is acting in bad faith in filing the application for invalidation. It states that it will file evidence of negotiations that took place in 2004 between the two sides with a view to the trade mark being assigned to Link. Almighty claims that Link did not raise the issue of the validity of the trade mark and was prepared to pay a substantial

sum of money for the registration. Almighty seeks the dismissal of the application and an award of costs.

4) Both sides filed evidence. Following the completion of the evidence rounds the sides were advised that it was considered that a decision could be made without recourse to a hearing. However, they were advised that they still retained their rights to be heard. Neither side requested a hearing and both sides furnished written submissions.

EVIDENCE

Initial evidence of Link

5) This consists of a witness statement by Karen Young. Ms Young is the company secretary of Link. She exhibits a printout from “Oxford English Dictionary Online”, with a copyright date of 2005. This defines moo as being the lowing sound made by a cow. It also refers to colloquial use, chiefly in North America and Australia, as meaning a cow. The printout also refers to MOO JUICE, which is described as being a colloquial North American (originally United States) term for cow’s milk. Use of MOO JUICE is recorded as being from the “Waukesha Freeman” of Wisconsin of 24 January 1940, Mezzrow and Wolfe’s “Really the Blues” from 1946 and PJ O’Rourke’s “Parliament of Whores” from 1992. References from the same source are exhibited in relation to the meaning of juice. There are a variety of meanings for juice given. Ms Young makes specific reference to the following:

“The fluid part or moisture of an animal body or substance; now usually in *pl.* the various liquid constituents of the body, the bodily ‘humours’; also used in *sing.* In the names of digestive secretions (*gastric j., intestinal j., pancreatic j.*).”

and

“**b. transf. and fig.** Cf. MILK v. 4.

1915 *Dialect Notes* IV. 227 *Juice*....to milk. Formerly very common, this verb is now chiefly used facetiously (as ‘*Juice* the heifer’). **1961** *New Left Rev.* May-June 47/1 The actors..juiced the improvisational tendency in the play...Some of the minor characters were even playing for laughs. **1975** *Business Week* 17 Feb. 54/2 As was the case during last year’s decline, some stocks have been juiced by tender offers.”

Exhibited is an extract from “Random House Historical Dictionary of American Slang” Volume 2, H-O. In this extract the following definition is given:

“**moo juice** *n.* milk or cream; COW JUICE; MOO, 2.

1942 *ATS* 105: Milk or cream...*cow, cow* or *moo juice*. **1945** *Calif.Folk Qly.* IV 52: Occasionally a waggish hasher demands “Moo juice!” or “Cat beer!” **1946** Mezzrow & Wolfe *Really Blues* 109: Leave the milkman a note telling him to nix out the moo-juice. **1970** E.Thompson *Garden of Sand* 299: Get the kid a horsecock and cheese

sandwich and some moo juice. **1976** *N.Y. Folklore* II 239: Milk is called *moo juice* by many. **1991** *Simpsons* (Fox-TV): Pass the moo juice.”

Also exhibited is an extract from “Straight from the Fridge Dad A Dictionary of Hipster Slang” by Max Décharné which refers to MOO-JUICE as meaning milk. The extract was downloaded on 28 September 2004. The source given is Mezzrow & Wolfe’s “Really The Blues” from 1946. Other definitions given include: moose-eyes meaning a leering dude, moocher meaning a small time panhandler or beggar, moss meaning hair and make like a fish meaning have a bath. There is an extract from “The Hipster’s Dictionary”, downloaded on 24 September 2004, from theatredance.com. It describes itself as “a copasetic compendium of hep cat hype and swing-era slang”. MOO JUICE is listed as meaning milk. Other definitions include main on the hitch for husband, man in gray for postman, jelly for anything free and mitt pounding for applause. There is a printout from the American Diner Museum website, downloaded on 24 September 2004. This states that a list of “Diner slang” has been compiled; it defines MOO JUICE as milk. Other definitions include flowing Mississippi for black coffee, a cup of mud for a cup of coffee, yum yum for sugar, canned cow for evaporated milk and warts for olives. Exhibited is an extract from “The Cassell Dictionary of Slang”; this defines MOO JUICE in the following manner:

“**moo juice** *n.* [1930s+] [orig. US Black] milk [MOO(-COW) + SE *juice*]”

A promotion for “Straight from the Fridge Dad A Dictionary of Hipster Slang” by Max Décharné from noexit.co.uk is exhibited. This was downloaded on 6 October 2004, it states that the book was published in October 2000. This includes the following: “Need a black coffee? That’s a shot of java, nix on the moo juice.” There is a review of the same book from richmondreview.co.uk, downloaded on 24 September 2004, which includes the same reference to MOO JUICE. A copy of a piece from “The Times” of 2 March 2001 is exhibited. It is entitled “Jive is revived – Style”. This article again deals with “Straight from the Fridge Dad A Dictionary of Hipster Slang” and has the reference to “Java nix the moo juice”. Other quotations from the book include line your flue for eat and Alabama lie detector for police baton. There is a review of the same book from “The Economist” of 3 February 2001. There is no reference to MOO JUICE specifically. Ms Young states that she “understands” that there were reviews of the same book in “Esquire”, “Time Out”, “Mojo”, “Loaded” and “ID”. Exhibited is a copy of a screen shot and the accompanying dialogue from “The Simpsons” (the episode entitled “Brush with Greatness):

“Marge: That’s wonderful, isn’t in kids?

Lisa: [to Bart] Pass the moo juice.

Marge: Kids, remember what I told you about showing a little support?

Lisa: Way to go, Dad!

Bart: You look mahvelous!

Maggie: [toasts Homer with her bottle of formula]”

Also exhibited is an exchange of emails with BSkyB Viewer Solutions. From this exchange it has been ascertained that the episode was first broadcast on Sky One on 1 September 1991. It has been broadcast thirty times. Ms Young states that she “understands” that the episode was first broadcast on BBC2 on 13 June 1997; after the

date of application. Ms Young states that “The Simpsons” attracts a large audience in the United Kingdom. She gives average viewing figures for parts of 2004; after the date of application.

6) Ms Young exhibits the front page of a summary for a Google search for “moo juice” conducted 18 October 2004. There is no indication that the search has been restricted geographically, none of the summaries indicate that the sites are based in the United Kingdom. 3,640 hits for “moo juice” are recorded. Ms Young exhibits a printout from the “Chicago Tribune” of 3 September 2004 headed “Low tide for moo juice”; it deals with the decline in milk consumption in the United States. There is a printout headed “Rocket Fuel Found in Moo Juice”, it is dated 22 June 2004 and indicates that it emanates from San Francisco. The article deals with a claim that young children and pregnant women who drink milk from Californian cows may be exposed to unsafe levels of a toxic chemical used in rocket fuel. Three pages, downloaded on 1 October 2004, are exhibited from holsteinworld.com. These pages relate to Holstein cattle. The pages are headed Moo Juice Holsteins (with the device of a head of a cow). The pages emanate from New York State, Moo Juice Holsteins would appear to be being used as a trade mark. Five pages are exhibited from alternet.org. They were downloaded on 1 October 2004. The pages are headed: “Not Milk: The USDA, Monsanto, and the U.S. Dairy Industry”. The article was posted on 9 July 2002. A related article runs to the side of the main article and is headed “Monsanto’s Moo Juice”; it deals with the use of bovine somatotropin. There is a printout from yell.com downloaded on 28 September 2004. This indicates that a search was made for companies called “moo juce” in the United Kingdom. There is one result: Moo Juce Ltd of 5, New Road, London. It is classified as a take away food company. A copy of a picture of the Moo Juce café is exhibited. Ms Young states that the café sold a selection of milk-based beverages. Ms Young states that Boultham Park Dairy in Lincoln has sold milk under the name MOO JUICE. She exhibits a page downloaded from foon.co.uk on 13 August 2004 showing a MOO JUICE label for semi-skinned milk. She states that there is a new milk delivery company called Moojuice in Haverhill, Suffolk. She states that this delivers milk and other dairy produce to more than 4,000 households in the surrounding area. A report is produced from the “Cambridge Evening News” of 14 September 2004 about the new milk delivery service, Moojuice.

7) Ms Young goes on to deal with the issues of genuine use of the trade mark and bad faith which are not matters under consideration in this case. She goes on to deal with Almighty’s claim that that Link is acting in bad faith in making its application for invalidation. This claim does not have a bearing upon the outcome of the case and so I will say no more about this part of the evidence.

Evidence of Almighty

8) This consists of witness statements by Victoria Jane Martin and Mark Cooper.

9) Ms Martin is a trade mark attorney. On 21 February 2005 Ms Martin contacted the Oxford University Press. She spoke by telephone to a Ms Kirsty Lewis and asked if she could inform her as to which Oxford dictionaries the expression MOO JUICE had appeared, and on which date(s) any entries had appeared. On 22 February 2005 Ms Martin received an email from a Margot Charlton, to whom Ms Lewis had forwarded the enquiry. The email states:

“The expression ‘moo juice’ does not appear in any of our printed dictionaries. It is only in the online version of the full *Oxford English Dictionary*, and it was added in March 2004. It is labelled ‘North American (originally U.S.) colloquial’, and all the illustrative quotations are from U.S. sources; the earliest dates back to 1940. I suspect that it is still rare in British use.”

10) Mr Cooper is a director of Almighty. A large part of Mr Cooper’s statement is not evidence of fact but submission and a critique of the evidence of Ms Young. I bear in mind Mr Cooper’s submissions in reaching my decision but will confine my summary of his statement to any evidence of fact that are material to this case.

11) Mr Cooper exhibits at MC1 an extract from what he describes as the “Shorter Common Oxford Dictionary”. This gives a definition of milk. Mr Cooper exhibits at MC2 a printout indicating that “The Cassell Dictionary of Slang” was published in London in 1998. This exhibit also includes a printout from amazon.co.uk which has a review of the book. It is indicated that it is a paperback edition that was published in December 2000. Mr Cooper states that the Moo Juice café is no longer trading. He states that the café owner next door to the former premises of Moo Juice advised him that the café opened in January/February 2004 and closed in August 2004. Mr Cooper states that he was most concerned to learn from Ms Young’s statement about the sale of milk under the name MOO JUICE by Boultham Park Dairy. He contacted the Boultham Park Dairy advising it of Almighty’s registered trade mark and received a response stating that it has never used the term MOO JUICE on any of its containers. Mr Cooper states that he also contacted the delivery company in Haverhill, referred to by Ms Young. It was unaware that MOO JUICE is a registered trade mark and has asked to licence it in relation to milk and other milk and dairy products.

12) Mr Cooper goes on to deal with issues relating to lack of genuine use and bad faith, which are not pertinent to this case. He also deals with Almighty’s claim that the application for invalidation was made in bad faith. Again something that does not affect my decision.

Evidence in reply

13) This consists of a further witness statement by Karen Young. Parts of Ms Young's statement do not represent evidence of fact but submission and comment on the statement of Mr Cooper. I will confine this summary to evidence of fact. Although, I bear in mind Ms Young's comments in reaching my decision. Ms Young exhibits email correspondence with Dr Jeremy Marshall, an associate editor of the Oxford English Dictionary. He advises that moo juice does not appear in any of the Oxford University Press's printed dictionaries simply because they can only be revised and republished every few years whereas the complete Oxford English Dictionary has a continuous revision programme and its existence in an online form allows the Oxford University Press to release batches of new material on a quarterly basis. He comments that the fact that an expression is rare in British use has no bearing on its inclusion in the Oxford English Dictionary. Dr Marshall states that term is marked as a North American colloquialism; he comments that "no doubt the ubiquity of the American media will have made it known to some people in Britain". He states that there was evidence of use of the term going back over sixty years. Dr Marshall finishes by writing that the entry in relation to moo in the Oxford English Dictionary does not mean that it is confined exclusively to North America and Australia. The example cited for 1967 is from the United Kingdom publication "The Listener".

14) Ms Young exhibits a printout from mirror.co.uk. This appears to be the online version of the "Daily Mirror". The printout is of an article dated 17 March 2005. Included in the article is the following:

"Celebs such as Jennifer Aniston, Britney Spears, Sarah Michelle Gellar and Tess Daly have all been seen guzzling a long, cool glass of moo juice."

Ms Young exhibits pages from the website moojuce.com, downloaded on 12 November 2004. This website relates to the Moo Juice café. The use of Moo Juice throughout appears to be trade mark use.

DECISION

15) Almighty has referred to the application for invalidation being made in bad faith. I have referred to this above in the summary of the evidence. I do not know what pertinence this claim has. I cannot see that an application can be struck out because the registered proprietor considers that the applicant's motives are questionable. There is no abuse of process in the application, as far as I can see. So I cannot see that the application can be struck out because of the motivation of Link. The question before me is whether the grounds for invalidation are valid. I am not interested in the motivation for the action. I can see that Almighty considers it disingenuous for Link to try to purchase the trade mark and later, following a breakdown in negotiations, to have the registration invalidated. However, such possible disingenuous in opposition and invalidation proceedings is not unheard of. Having failed in negotiations Link is trying another means of achieving its ends. I will, therefore, deal with the matter simply upon the basis of whether the trade mark's registration should be declared invalid upon the basis of sections 3(1)(b), (c) and/or (d) of the Act.

16) Section 47 of the Act reads:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

17) Section 3(1) of the Act states:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

18) As section 3(1)(d) has been invoked it is necessary to decide what the material date is. Article 3 of First Council Directive 89/104 of December 21, 1988 (the Directive):

“1. The following shall not be registered or if registered shall be liable to be declared invalid:

.....

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;”

The proviso of Article 3.3 of the Directive:

“3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1 (b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.”

According to the proviso a trade mark shall not be declared invalid if it has acquired a distinctive character before the date of application. So the Directive states that a trade mark cannot be declared invalid because of later circumstances if it had acquired distinctiveness before the date of application for registration. Invalidation is about the incorrect registration of a trade mark, the act of registration. A registration cannot

become invalid because afterwards the trade mark becomes a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade. Future events may limit the penumbra of protection, they may leave a trade mark open to attack as having become the name in trade of a product or service (Article 12.2(a) of the Directive), they do not make the act of registration invalid. The invalidity provisions of the Act state that they apply where the trade mark “was registered”, referring to the act of registration and the time. In *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 Morritt LJ stated:

“22. Having considered the various categories of evidence to which I have referred the judge posed to himself three questions. It is common ground that the questions were the right ones, but in view of some of the argument it is necessary to set them out. They were:

1. Whether the trade mark was properly registrable as at the date of registration without reliance on any distinctive character which it may have acquired as a result of the use which had been made of it;
2. Whether it was properly registrable on the basis of any distinctive character which it had acquired as a result of the use that had been made of it; and
3. Whether it has acquired a distinctive character as a result of the use which has been made of it to date.”

Again the question of invalidation is related to date of registration, which is the date of application. (Section 40(3) of the Act states:

“(3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.”)

Even if section 40(3) of the Act was not there, the material date would still be the date of application. The question of the validity of the registration would relate to the position at the date of application, subject to the use after registration proviso. A clear definition of the material date was given by the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) in *Alcon Universal Ltd v Dr Robert Winzer Pharma GmbH* Case R 273/2000-1:

“15 Since the date of filing the Community trade mark application for the sign BSS is 1 April 1996, the distinctive character must be appreciated by this date. In consequence, the evidence provided by the cancellation applicant to prove that the sign is not inherently distinctive must relate to a period ending on the date of application and not after. Furthermore, since the trade mark has been registered for very specific goods, the relevant public against which to judge the distinctive character of the mark is not the general public but, medical doctors skilled in ophthalmology and pharmacists.”

This case went on to be considered by the Court of First Instance in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-237/01 [2004] ETMR 6, it accepted that the material date was the date of application, subject to the use proviso. This case was under Council Regulation (EC) No 40/94, however, there is no divergence in language from the Directive or the Act

which would lead to a different outcome in the United Kingdom. The only divergence from this position as to the material date that I am aware of is that of Advocate General Ruiz-Jarabo in Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* and Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v Office for Harmonization in the Internal Market (Trade Marks and Designs)* and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v Office for Harmonization in the Internal Market (Trade Marks and Designs)* where he stated:

“43. I concur with the Office's reasoning. As it explains, that is the logical outcome if the absolute grounds of refusal in Article 7(1) of the regulation are read in conjunction with Article 51 thereof, which, under the heading Absolute grounds for invalidity, includes the ground that a trade mark *has been registered* in breach of the provisions of Article 7. The appellants' stance would mean that a mark would have to be registered but could immediately be annulled pursuant to a declaration of invalidity on the ground that it did not have the necessary distinctive character at that point in time. The intention of the legislature cannot have been so illogical; therefore the assessment of the requisite conditions for registration must be made at the time of registration.”

This is not an issue with which European Court of Justice dealt. However, I cannot see that *has been registered* ties the potential nullity of the registration to the date of the completion of the registration process rather than to the date of application/registration. It can readily be read as indicating that a trade mark was registered contrary to the provisions of Article 7 based upon the date of application ie at the date of application registration of the trade mark was contrary to Article 7 and so the application had been registered in breach of the relevant provisions. I will take the date of application, 4 December 1995, as the material date in this case.

19) Each of the grounds under section 3(1) is independent of the others and calls for separate examination. “Furthermore, the various grounds for refusal must be interpreted in the light of the public interest underlying each of them. The public interest taken into account in the examination of each of those grounds for refusal may, indeed must, reflect different considerations, depending upon which ground for refusal is at issue (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46, and the *SAT.1* judgment, paragraph 25).” (see *Celltech R&D Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T-260/03). For each of the grounds the consideration of the trade mark has to be based upon the basis of the goods for which it is registered.

Findings of fact

20) In its statement of case Link claims that MOO JUICE is in common parlance. The presumption must be that as this is a United Kingdom registration, the claim that the term is in common parlance relates to the United Kingdom. As far as material date goes, Link needs to establish that MOO JUICE is in common parlance before 4 December 1995. The basis for the claim of common parlance within the United Kingdom rests on trade mark use by a café of Moo Juice, alleged use by Boultham Park Dairy as a trade mark (which is categorically denied) and use by a milk round as a trade mark. There are then references to Mr Décharné's publication, a dictionary. This dictionary was published in 2000, after the material date, so consequently the reviews referring to moo juice are after the material date. A dictionary reference, even if published before the material date, in itself says little. If you open many dictionaries, and certainly if you open the "Oxford English Dictionary" or the "Shorter Oxford English Dictionary", you will find a host of words unknown to all but a few philologists and lexicographers. In this case the dictionary includes such definitions as line your flue for eat and Alabama lie detector for police baton. Is the argument of Link that anything that appears in a dictionary becomes part of common parlance? The logical, if extreme, extension of this is that because I have a Dutch dictionary that is published in the United Kingdom all the words in that become part of common usage. A phrase or word can be foreign in the United Kingdom even if it is in English from another country. I am sure that there are many people who are bemused by certain words and phrases used in United States films and songs. It is reasonable to assume that the reviews quoted the most memorable and unusual references. Why would they quote what is in common parlance? The reference to moo juice comes from the quotation "Java nix the moo juice". None of that phrase has any meaning to me. The dictionary references show that moo juice is a North American phrase. Dr Marshall speculates that the ubiquity of the American media might have made the phrase known to people in the United Kingdom. He does not state that the dictionary is going to be altered to show British usage. There is an episode from "The Simpsons", if the foundations of the claim to common parlance are on the basis of Lisa Simpson in one episode using the phrase moo juice, they would seem to be built on shifting sands. One then has an article from the mirror.co.uk. This is from 1 March 2005, well after the material date.

21) This seems to me to be a case of the dog that didn't bark. Link seemed to have scoured the Internet, employed investigators, yet have come up with a paucity of evidence of use of moo juice in the United Kingdom; there is no evidence that the average consumer or traders know or understand the phrase.

22) Link also tries to build a case on the use of moo for cow and juice for milk. Again there is a paucity of evidence. I, like many, have heard of moo cows but have never heard a cow described as a moo. Again there is a reliance on dictionary evidence, which does not necessarily reflect the world. There is one reference to a British publication in 1967, the now defunct "Listener": "Those bells which announce the approach of psychedels like medieval lepers or a herd of moos". I am afraid that I have no idea of what a psychedel is. The piece would also seem to be more "Finnegan's Wake" than "The Grocer". The use of juice in relation to milk appears to be use as a verb – to milk. There is the reference to juice the heifer. There is a paucity of evidence in relation the claims about moo and juice.

23) On the basis of the evidence before me I do not consider that moo juice is in the common parlance in the United Kingdom as a synonym for milk, and was not at the material date. Nor, do I consider that moo and juice, in the United Kingdom, have been established as synonyms for cow and milk respectively either with the average consumer or the trade. The evidence shows moo juice is a phrase that has been used in North America; how pervasive that use is, I cannot tell.

Section 3(1)(d) of the Act

24) In *Merz & Krell GmbH & Co* (C-517/99) [2002] ETMR 21 the European Court of Justice (ECJ) established the criteria to be taken into account in considering section 3(1)(d) of the Act:

“31. It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.
.....

39. It also follows that, where the signs or indications concerned have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by the mark, it is of little consequence that they are used as advertising slogans, indications of quality or incitements to purchase those goods or services.

40. However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. It is for the national court to determine in each case whether the signs or indications have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark.

41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

In *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-237/01 [2004] ETMR6 the Court of First Instance (CFI) considered this issue:

“37. According to the Court of Justice, Article 3(1)(d) of Directive 89/104 must be interpreted as precluding registration of a trade mark only where the

signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (*Merz & Krell*, paragraph 31). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services and, secondly, on the basis of the target public's perception of the sign.

39. The Court of Justice further held that, although there is a clear overlap between the scope of Articles 3(1)(c) and 3(1)(d) of Directive 89/104, marks covered by Article 3(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (*Merz & Krell*, paragraph 35).

There has been some debate as to what the wording of the Act and the Directive means. Is it customary in the current language qualified by established practices of the trade or is it stand alone? This was considered by Professor Annand, sitting as the appointed person, in BL O/281/04. In that case she stated:

“In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

In this case it has not been established that at the material date, or at the date of the completion of the registration process, that MOO JUICE has been used customarily in relation to milk and milk related products. Indeed, if a negative were to be proved, it is that MOO JUICE is not customarily used in relation to such goods. So, like Professor Annand, I do not need to consider the nuances of the wording of the Act. On either understanding of the meaning of the wording the case fails.

25) The ground for invalidation under section 3(1)(d) of the Act is dismissed.

Section 3(1)(c) of the Act

26) The ECJ dealt extensively with the issues underlying section 3(1)(c) of the Act in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 [2004] ETMR 57:

“56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that

assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58. Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.....

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.”

In paragraph 55 of *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ points out the public interest issue underlying section 3(1)(c) of the Act:

“55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.”

27) The prohibition under this section of the Act relates to signs that **may** serve in trade to designate some characteristic of the goods. It is necessary to consider the future as well as the present. Having dismissed the claim that MOO JUICE is a phrase customarily used it is necessary to consider under this section of the Act whether the combination of the two elements creates a sign that describes some characteristic of the goods. I have already indicated that I am unconvinced by the claims that MOO is a synonym for cow and JUICE for milk. I do not consider that either of these words is descriptive of the goods of the registration. However, that does not mean that the bringing together of the two elements might not create a descriptive whole. It could be that the reverse is the case of where two non-distinctive elements create a distinctive whole; it might be that two distinctive elements in combination create a non-distinctive whole. The ECJ has held on various occasions that trade marks should be considered in their entirety (see *Procter & Gamble Company v OHIM*, Joined Cases C-468/01 P to C-472/01 P [2004] ETMR 88 and *Eurocermex SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-286/04 [2005] ETMR 95). It has also held that it will also be necessary to consider the component parts of a trade mark in reaching a conclusion (*SAT.1 SatellitenFernsehen GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-329/02 P – “the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise”). The trade mark takes the onomatopoeic sound of a cow’s lowing with the word that, in the context of beverages, relates to the liquid extracted from fruits or vegetables. By consideration of the goods and the trade mark it will be seen as an amusing, cryptic allusion to the goods. However, it is far more a crossword clue than anything approaching a description. In the absence of evidence of any knowledge in the trade of the term (as per the section 3(1)(d) of the Act analysis), I do not consider that the trade mark consists exclusively of a sign that designates some characteristic of the goods. In my view it is a clever trade mark that will gain immediate recognition as such (see *Quick restaurants SA v Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* T-348/02). I see no reason that the MOO JUICE should be left free for others to use and so there is no public interest argument for invalidation under this ground.

28) The ground for invalidation under section 3(1)(c) of the Act is dismissed.

Section 3(1)(b) of the Act

29) In *Henkel KGaA v Deutsches Patent – und Markenamt* C-218/01 the ECJ identified the essential purpose of a trade mark

“30 As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and *Philips*, cited above, paragraph 30).”

In *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (LITE)* Case T-79/00 [2002] ETMR 91 the CFI stated:

“26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

In *Linde AG v Deutsches Patent- und Markenamt* Joined Cases C-53/01 to C-55/01 [2003] ETMR 78 the ECJ stated:

“For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, para.[35]).”

In relation to section 3(1)(b) the average consumer must be considered. For the goods of the registration, this will be the public at large. I consider that MOO JUICE will readily fulfil the purpose of a trade mark – guaranteeing that all the goods bearing the trade mark originate under the control of a single undertaking. The trade mark will readily be able to repeat the experience of acquiring the goods sold under the trade mark, or readily avoid purchasing them.

30) The ground of invalidation under section 3(1)(b) of the Act is dismissed.

Conclusion

31) All of the grounds for invalidation have been dismissed. Almighty has claimed that there has been use of the trade mark. I do not consider that taking into account the nature of the goods and the nature of the evidence that the evidence would support a finding that the trade mark had become distinctive through use, if I am wrong in my primary findings.

32) Most of the evidence has dealt with American usage. American and British English do diverge; they may use the same words meaning different things. In such cases it may be necessary to view the languages as being different languages. Such is the case here. There is no indication that the British public has been exposed to the phrase MOO JUICE in such a manner that it will have seen it as a synonym for milk. The best that Link can muster to support its case is one incidence in one television programme. Future use of an American phrase is covered by the need to leave free; and as I have stated I see no reason that there is any need to leave the phrase MOO JUICE free for use by others. I certainly cannot see that Link has explained why there is such a need.

COSTS

33) Almighty Marketing Limited having been successful is entitled to a contribution towards its costs. I order Milk Link Limited to pay Almighty Marketing Limited the sum of £1750. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of March 2006

**David Landau
For the Registrar
the Comptroller-General**